

Amendments to the Drawings:

The drawing sheet attached in connection with the above-identified application containing Figures 4-6 is being presented as a sheet to be substituted for the previously submitted drawing sheet. Figure 5 has been amended. Appended to this amendment is an annotated copy of the previous drawing sheet which has been marked to show changes presented in the replacement sheet of the drawing.

The specific change which has been made to Figure 5 is the addition of the clamping apparatus 40, which finds support, *inter alia*, in the original specification at the paragraph starting at page 5, line 10, and original claim 3.

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Currently, claim 1 is amended, claims 2-5 are canceled, and claims 6-9 are added. After amending the claims as set forth above, claims 1 and 6-9 are now pending in this application.

Applicant wishes to thank the Examiner for the careful consideration given to the claims.

Drawings

The drawings are objected to under 37 CFR 1.83(a) because the “clamping apparatus” and “jig” of claims 3 are not shown in the figures. Although claim 3 has been canceled, new claims 7 and 9 relate to a method that uses a clamping apparatus. In order to expedite prosecution, the Applicants have amended Figure 5 that schematically illustrates the clamping apparatus. Support for the clamping apparatus can be found, *inter alia*, in the original specification at the paragraph starting at page 5, line 10, and original claim 3. Applicants have submitted amended Figure 5 solely to expedite prosecution and do not believe that this amendment to the figure is necessary to understand the invention.

Rejection of claims 1 and 2 based on Birkert.

Claims 1 and 2 are rejected under 35 U.S. 102(e) as being anticipated by U.S. Patent Application Publication 20040182547 to Birkert et al. (“Birkert”) For at least the following reasons, this rejection is traversed.

Birkert is not considered prior art upon which a rejection can properly be based. Birkert is a published U.S. Patent Application that is a national stage filing based on a PCT application. The § 102(e) date of such a publication is governed by satisfaction of the requirements of 35 U.S.C. § 371. In this case, the § 371/102(e) date of Birkert is not the PCT filing date. For such a rejection to be valid, the WIPO publication of the PCT application (WO 03/064953) must have been made in English and designate the U.S. In this case, the WIPO publication is not in English. Therefore, the PTO cannot rely on the PCT filing date of Birkert to reject the claims under § 102(e). Thus, no § 102(e) rejection can be made using this reference. Additionally, no other § 102 rejections can be made using Birkert, because its U.S. publication date of September 23, 2004, and also the publication date of both the WIPO

publication and the publication of the German priority application are after the U.S. filing date of the present application, which is the filing date of the PCT application on June 23, 2003. For at least this reason, favorable reconsideration is respectfully requested.

Rejection of claims 3-5 based on Birkert and Banzhaf.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birkert in view of U.S. Patent 6,269,870 ("Banzhaf"). This rejection is traversed as it may be applied to the new claims, for at least the reason that Birkert is not prior art and cannot serve as a basis for a § 103 rejection, as explained above. For at least this reason, favorable reconsideration is respectfully requested.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5414
Facsimile: (202) 672-5399

By Matthew J. Kremer

Richard L. Schwaab
Attorney for Applicant
Registration No. 25,479

Matthew J. Kremer
Attorney for Applicant
Registration No. 58,671

Title: EXHAUST GAS HEAT EXCHANGER AND METHOD FOR THE PRODUCTION THEREOF

Inventor(s): Steffen BRUNNER et al.

Appl. No.: 10/518,590

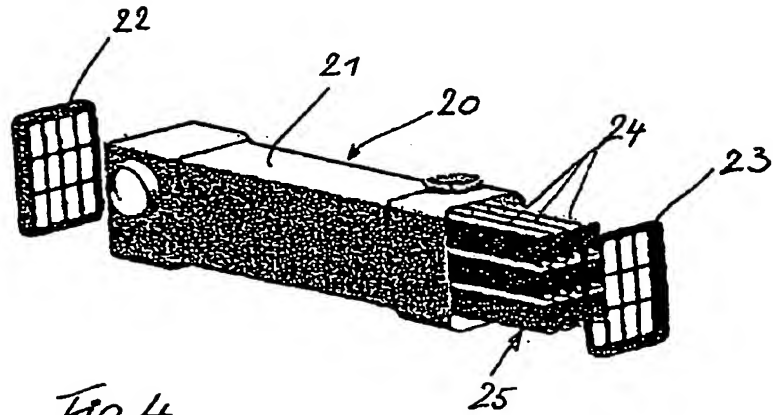


Fig. 4

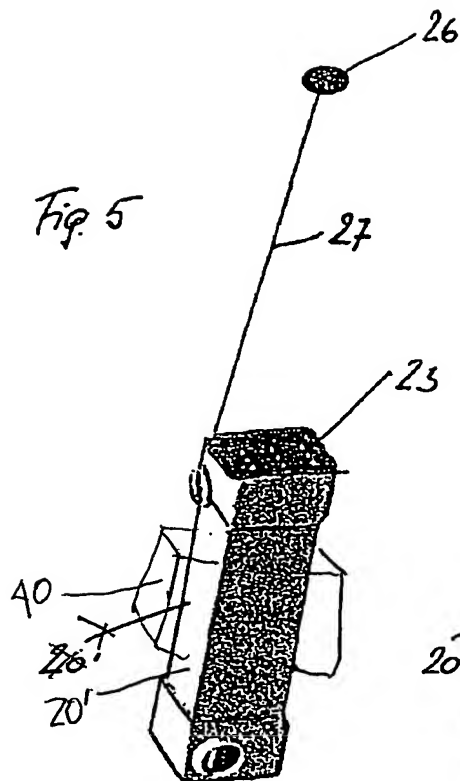


Fig. 5

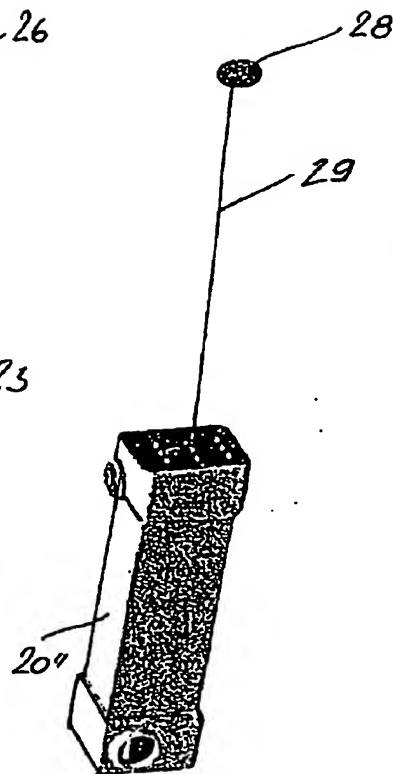


Fig. 6